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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/605,433	KELLEY ET AL.
	Examiner	**Art Unit**	
	Khanh B. Pham	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-29 and 31-45* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 5-29, 31-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January

19, 2007 has been entered. Claims 1, 9, 18, 25-29, 31, and 39 have been amended.

Claim 30 have been canceled. Claims 1-2, 5-45 are pending in this Application.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

         While the preamble of claim 25 recites "a system", the body of claim 25 recites

steps of a method. Claim 25 is directed to neither a "process" nor a "machine", but

rather embraces over or overlaps two different statutory classes of invention set forth in

35 U.S.C 101 which is drafted so as to set forth the statutory classes of invention in the

alternative only. See Ex parte Lyell, 17 USPQ2d 1548 and MPEP 2173.05(p)..

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 1-2, 5-29, 31-45** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Shanahan et al. (US 2003/0033288) and in view of Conner et al. (US

6,816,882 B1), hereinafter **Shannahan** and **Conner.**

As per claim 18, Shanahan teaches a method for providing web-based

electronic research and presentation function via a document creation application

comprising:

- "scanning an active document on a computer device operable for identifying

  relevant keywords" at [0008], [0009], [0131];

- "searching at least one database for reference materials relating to said relevant

  keywords" at [0132], [0135];

- "automatically displaying relevant materials on said computer device" at [0120],

  [0189], [0285], [0339] and Fig. 63;

- "converting said reference material if said reference material are in a format

  different from a format used in creating said active document" at [0139], [0503],

  [0525];

- "displaying said reference materials on said computer device" at [0219];

- "wherein said active document includes data currently being entered or edited by a user on said computer device" at [0138];

Shanahan does not explicitly teach the on demand sharing of process for performing functions as claimed. However, Conner teaches an on demand sharing of process software for providing said web-based application (Col. 7 lines 25-35) comprising:

- creating a transaction containing unique customer identification, requested service type, and service parameter" at Col. 13 lines 7-40;

- "sending said transaction to at least one main server" at Col. 13 lines 40-50;

- "querying said at least one main server about processing capacity associated with said at least one main server to help ensure availability of adequate resources for processing of said transaction" at Col. 14 lines 55-67, Col. 17 lines 4-18;

- "allocating additional processing capacity when additional capacity appears needed to process said transaction, said additional processing capacity being selected from the group of additional capacities consisting of central processing unit capacity, processor memory capacity, network bandwidth capacity and storage capacity" at Col. 14 lines 5-35, Col. 17 lines 4-18;

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Shanahan's system to provide a web based on demand sharing of process software as taught by Conner be cause "it would be advantageous to

provide a flexible IT model without the total cost of ownership problem associated with personal computing" as suggested by Conner at Col. 2 lines 54-56.

As per claim 1, Shannahan and Conner teach the method of claim 18 as discussed above. Shannahan also teaches:

"wherein said scanning an active document on a computer device operable for identifying relevant keywords is performed by an intelligent search agent, said method further including: scanning text of an active page for said active document for at least one of: frequently appearing terms" at [0007], [0255], [0307], and Figs. 21, 22, 28;

"frequently appearing phrases" at [0307] and Fig. 28;

"and specific terms requested by said user at [0294], [0295], [0298];

"determining relevance of found terms or phrases resulting from said scanning, said determining relevance of found terms or phrases based upon rules prescribed by said intelligent agent" at [0158], [0319], [0320];

"and storing relevant results in a temporary storage location operable for performing said searching" at [0180].

As per claim 2, Shannahan and Conner teach the method of claim 1 discussed above. Shannahan further teaches:

"prompting said user to select all or a portion of said reference materials; if selected, formatting said all or a portion of said reference materials; and entering said

all or a portion of said reference materials into said active document" at [0139], [0340]-[0344], [0503], [0525].

As per claim 5, Shannahan and Conner teach the method of claim 1 discussed above. Shannahan also teaches:

"wherein said searching at least one database for said reference materials relating to said relevant keywords includes searching at least one of: a local database associated with said computer device" at [0450];

"and a remote database located in a network location external to said computer device" at [0297] and Fig. 3.

As per claim 6, Shannahan and Conner teach the method of claim 1 discussed above. Shanahan also teaches: "wherein said displaying said reference materials on said computer device includes: intermittently flashing text of said reference materials on a computer screen of said computer device" at [0173].

As per claim 7, Shannahan and Conner teach the method of claim 1. Shannahan also teaches: "wherein said displaying said reference materials on said computer device includes at least one of: displaying a Uniform Resource Locator associated with said reference materials on a computer screen of said computer device; and displaying a Uniform Resource Locator with a preview pane associated with said

reference materials on a computer screen of said computer device" at [0179] and Fig.

10..

As per claim 8, Shannahan and Conner teach the method of claim 1.

Shannahan also teaches: "wherein said displaying said reference materials on said

computer device includes: displaying text of said reference materials on a computer

screen of said computer device in response to a user highlighting a term or section of

text within said active document" at [0318].

As per claim 9, Shannahan and Conner teach the method of claim 1.

Shannahan also teaches : "wherein said displaying said reference materials on said

computer device includes performing at least one of: displaying images of said

reference materials on a computer screen of said computer device in response to a user

highlighting a term or section of text within said active document; displaying images in a

preview pane of said reference materials on a computer screen of said computer device

in response to a user highlighting a term or section of text within said active document"

at [0579] and Figs. 64, 65.

As per claim 10, Shannahan and Conner teach the method of claim 1.

Shannahan also teaches: "displaying text of said reference materials on a projector

screen via a presentation application executing on said computer device, said

displaying text of said reference materials on a project screen performed in response to

a user selecting said reference materials for display; wherein said projector screen is in communication with said computer device" at [0189], [0205].

As per claim 11, Shannahan and Conner teach the method of claim 1 discussed above. Conner also teaches:

- "deploying process software for providing said web-based electronic research and presentation functions via a document creation application, said deploying comprising: installing said process software on at least one server; identifying server addresses for users accessing said process software on said at least one server; installing a proxy server if needed" at Col. 6 lines 45-55;

- "sending said process software to said at least one server and copying said process software to a file system of said at least one server" at Col. 13 lines 43-55;

- "sending the process software to at least a first client computer; and executing said process software on said first client computer" at Col. 7 lines 25-40.

As per claim 12, Shannahan and Conner teach the method of claim 11 discussed above. Conner also teaches: "wherein said installing said process software further comprises: determining if programs will reside on said at least one server when said process software is executed; identifying said at least one server that will execute said process software; and transferring said process software to storage for said at least one server" at Col. 16 lines 3-25.

As per claim 13, Shannahan and Conner teach the method of claim 11 discussed above. Conner also teaches: "wherein said sending said process software to said first client computer further includes having said at least one server automatically copy said process software to said first client computer, and running an installation program at said first client computer to install said process software on said first client computer" at Col. 11 lines 10-20.

As per claim 14, Shannahan and Conner teach the method of claim 11, Conner also teaches: "said sending said process software to said first client computer further comprises identifying a user and an address of said first client computer" at Col. 11 lines 10-20.

As per claim 15, Shannahan and Conner teach the method of claim 11, Conner also teaches: "said sending said process software to said first client computer includes sending said process software to at least one directory on said first client computer" at Col. 11 lines 10-20.

As per claim 16, Shannahan and Conner teach the method of claim 11, Conner also teaches: "said sending said process software to said first client computer includes sending said process software to said first client computer via e-mail" at Col. 11 lines 10-20.

As per claim 17, Shannahan and Conner teach the method of claim 1, further comprising integrating process software for providing said web-based electronic research and presentation functions via a document creation application, said integrating comprising:

- "determining if said process software will execute on at least one server; identifying an address of said at least one server; checking said at least one server for operating systems, applications, and version numbers for validation with said process software, and identifying any missing software applications for said at least one server that are required for integration" at Col. 13-14 and Figs. 8-9;

- "updating said at least one server with respect to any operating system and application that is not validated for said process software, and providing any of said missing software applications for said at least one server required for said integration; identifying client addresses and checking client computers for operating systems, applications, and version numbers for validation with said process software, and identifying any software applications missing from said client computers that are required for integration" Col. 13-14 and Figs. 8-9;

- "updating said client computers with respect to any operating system and application that is not validated for said process software, and providing any missing software application for said client computers required for said

integration; and installing said process software on said client computers and

said at least one server" at Col. 13-14 and Figs. 8-9.

As per claim 19, Shannahan and Conner teach the method of claim 18, Conner

also teaches: "recording a plurality of usage measurements selected from the group of

usage measurements consisting of network bandwidth, processor memory, storage,

and central processing unit cycles" at Col. 14 lines 49-51.

As per claim 20, Shannahan and Conner teach the method of claim 19, Conner

also teaches: "summing said usage measurements; acquiring at least one multiplicative

value associated with said usage measurements and with unit costs; and recording any

such acquired multiplicative value as an on demand charge to a requesting customer" at

Col. 14 lines 1-35.

As per claim 21, Shannahan and Conner teach the method of claim 20, Conner

also teaches : "further comprising at least one of: posting said on demand charge on a

web site if requested by said requesting customer; and sending said on demand charge

via e-mail to said requesting customer's e-mail address" at Col. 14 lines 1-20.

As per claim 22, Shannahan and Conner teach the method of claim 20, further

comprising "charging said on demand charge to said requesting customer's account if

an account exists and if said requesting customer has selected a charge account

payment method" at Col. 14 lines 1-20.

As per claim 23, Shannahan and Conner teach the method of claim 1, Conner

also teaches "further comprising deploying, accessing, and executing process software

for providing said web-based electronic research and presentation functions via a

document creation application, said deploying, accessing, and executing process

software implemented through a virtual private network, the method further comprising:

determining if a virtual private network is required; checking for remote access to said

virtual private network when it is required; if said remote access does not exist,

identifying a third party provider to provide secure, encrypted connections between a

private network and remote users; identifying said remote users; and setting up a

network access server operable for downloading and installing client software on

desktop computers for remote access of said virtual private network; accessing said

process software; transporting said process software to at least one remote user's

desktop computer; and executing said process software on said at least one remote

user's desktop computer" at Col. 13-14.

As per claim 24, Shannahan and Conner teaches the method of claim 23,

further comprising: determining if said virtual private network has a site-to-site

configuration for providing site-to-site access, and if said virtual private network is not so

available, installing equipment required to establish a site-to-site configuration for said

virtual private network; installing large scale encryption into said site-to-site virtual

private network; and accessing said process software through said site-to-site

configuration with large scale encryption" at Col. 13-14.

Claims 25-29, 31-45 recite similar limitation as discussed above and are

therefore rejected by the same reasons.

Response to Arguments

6.   Applicant's arguments with respect to claims 1-2, 5-29, 31-45 have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the

references applied to the claims above for the convenience of the applicant. Although

the specified citations are representative of the teachings of the art and are applied to

specific limitations within the individual claim, other passages and figures may apply as

well. It is respectfully requested from the applicant in preparing responses, to fully

consider the references in entirety as potentially teaching all or part of the claimed

invention, as well as the context of the passage as taught by the prior art or disclosed

by the Examiner.

In the case of amending the Claimed invention, Applicant is respectfully

requested to indicate the portion(s) of the specification which dictate(s) the structure

relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is **(571) 272-3574** for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Khanh B. Pham
Primary Examiner
Art Unit 2166

September 24, 2007